FILED
OCT 8 1997
CLERK

(4)

No. 97-376

In The

Supreme Court of the United States

October Term, 1996

WARREN PUBLISHING INC.,

Petitioner,

v.

MICRODOS DATA CORP., et al.,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Eleventh Circuit

RESPONDENTS' BRIEF IN OPPOSITION

ROBERT B. KENNEDY
Counsel of Record
CARL M. DAVIS II
LESLIE C. RUITER
KENNEDY, DAVIS & KENNEDY
400 Northpark Town Center
1000 Abernathy Road
Suite 1250
Atlanta, Georgia 30328
(770) 396-2244

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

28 pp
$10

QUESTIONS PRESENTED

1. Whether certiorari should be granted where the Eleventh Circuit properly applied the law of compilation copyright from this Court's decision in *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), to the facts in the record and determined that the Appellant's selection of material for its compilation lacked creativity and originality and was therefore not copyrightable?

2. Whether certiorari should be granted where the Eleventh Circuit determined that Appellant's system of selecting material for its compilation was excluded from copyright protection under 17 U.S.C. § 102(b) which bars copyright protection for systems?

3. Whether certiorari should be granted where the Eleventh Circuit properly applied the copyright merger doctrine to the record and held that the expression in Appellant's work, a list of geographic names of areas served by cable systems, merged with Appellant's idea?

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

TABLE OF CONTENTS ii

TABLE OF AUTHORITIES iv

INTRODUCTION 1

STATEMENT OF THE CASE 1

1. Course of Proceedings and Disposition Below .. 1

2. Statement Of Facts 3

   A. Warren's "Selection" Of Material For Its "Factbook" Was Mere Discovery Of Community Names From Cable System Operators 3

   B. Microdos's Database Used Federal Communications Commission Reports Which Identify Cable Systems And Communities Served 5

REASONS FOR DENYING THE PETITION FOR WRIT OF CERTIORARI 7

1. Certiorari Is Not Warranted Because The Eleventh Circuit Decision Is Merely An Application Of *Feist* and *BellSouth* To The Facts Shown In The Record: Appellant Disagrees With The Factual Findings And The Application Of An Established Rule Of Law 7

2. Certiorari Is Not Warranted Because The Eleventh Circuit Properly Applied The Compilation Copyright Law Of *Feist* and *BellSouth* To The Record And Held There Was Not Sufficient Creativity Or Originality In Warren's Actions To Entitle It To Compilation Copyright Protection 11

TABLE OF CONTENTS – Continued

Page

a. There Was No Originality In Warren's "Selection" Of All Known Cable Systems 11

b. There Was No Originality In Warren's Organizing Principle Of Grouping Cable Systems By Communities Served 13

c. Warren's "Selection" Of Principal Community Is Merely The Discovery Of Facts And Is Original To The Cable Operators, Not To Warren 14

3. Certiorari Is Not Warranted Because "Systems" Under 17 U.S.C. § 102(b) Are Clearly Excluded From Copyright Protection 16

4. Certiorari Is Not Warranted Because The Eleventh Circuit Applied The Copyright Merger Doctrine To The Record And Held That The Expression In Warren's Work Merged With Its Idea 18

CONCLUSION 22

TABLE OF AUTHORITIES

Page

CASES

BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc., 933 F.2d 952 (11th Cir. 1991), *vacated and reh'g (en banc) granted*, 977 F.2d 1435 (11th Cir. 1992), *and on reh'g*, 999 F.2d 1436 (11th Cir. 1993) (en banc), *cert. denied*, 510 U.S. 1101, 114 S.Ct. 943, 127 L.Ed.2d 232 (1994) ..... *passim*

CCC Information Services v. MacLean Hunter Market Reports, Inc., 44 F.3d 61 (2nd Cir. 1994) 8

Cooling Systems and Flexibles, Inc. v. Stewart Radiator, Inc., 777 F.2d 485 (9th Cir. 1989) 18

Eckes v. Card Prices Update, 736 F.2d 859 (2nd Cir. 1984) 11, 12

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340 (1991) ..... *passim*

Key Publications v. China Town Today Publishing Enterprises, Inc., 945 F.2d 509 (2nd Cir. 1991) 8, 13

Lipton v. Nature Co., 71 F.3d 464 (2nd Cir. 1995) 8

Mason v. Montgomery Data, Inc., 967 F.2d 135 (5th Cir. 1992) 8, 19

Matthew Bender Co. v. Kluwer Law Book Publishers, Inc., 672 F.Supp. 107 (S.D.N.Y. 1987) 18

Morrissey v. Proctor & Gamble Co., 379 F.2d 675, 154 USPQ 193 (1st Cir. 1967) 18

Mid America Title Co. v. Kirk, 59 F.3d 719 (7th Cir. 1995) 8

TABLE OF AUTHORITIES – Continued

Page

National Rifle Assn. v. Handgun Control Federation, 844 F. Supp. 1178 (D.C. Ohio 1992) 9

Toro Co. v. R&R Products Co., 787 F.2d 1208 (8th Cir. 1986) 17, 18

STATUTES

17 U.S.C. § 102(b) 10, 16, 17

28 U.S.C. § 1338(a) 2

TREATISE

R. Nimmer, *Nimmer On Copyright* (1997) § 2.18[C]. 18

RULES

Rules of the Supreme Court of the United States (May 1, 1997) 7

47 C.F.R. §§ 76.12, 76.400, 76.403 5

INTRODUCTION

Appellant Warren Publishing ("Warren") seeks writ of certiorari for appeal of an *en banc* decision applying the legal principles of this Court in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), on compilation copyright to the particular circumstances of this case against Appellee Microdos Data Corp. and Robert Payne ("Microdos"), where the court below held that Warren's system of selection lacked creativity and originality and was instead a mere discovery and collection of known facts, not entitled to copyright protection.

STATEMENT OF THE CASE

1. Course of Proceedings and Disposition Below

The present petition arises from an *en banc* decision on June 10, 1997, by the Eleventh Circuit which held that the copyright claimant Warren failed to show that the selection of facts in its compilation was sufficiently original to be entitled to copyright protection. 115 F.3d 1520, 1521, Pet. App. 26a.

The case was on appeal from a district court action filed July 26, 1990, by Warren against Microdos and Robert Payne for copyright infringement under 28 U.S.C. § 1338(a) and for unfair competition. R1-1. Microdos counterclaimed for defamation and trade disparagement, interference with contractual obligations, and violations of Section 2 of the Sherman Antitrust Act by Warren attempting to monopolize. R1-6. 115 F.3d at 1513, Pet. App. 8a.

Following discovery, the parties cross-moved for partial summary judgment on the claims for copyright infringement. R1-19; R2-22. On March 23, 1992, the district court entered an order granting Warren's motion and held that "the system [of selecting communities] utilized by Warren in presenting the data on cable systems in its *Factbook* was sufficiently creative and original to be copyrightable." Dist. Ct. Op. at 11, Pet. App. 83a, 115 F.3d at 1513, Pet. App. 9a. A motion for reconsideration was denied and an injunction entered against Microdos. 115 F.3d at 1514, Pet. App. 9a.

In a first appeal to the Eleventh Circuit, the court affirmed the district court. 52 F.3d 950, Pet. App. 53a. The dissent, however, was unable to conclude that Warren's acts of selection were sufficiently original to merit copyright protection (52 F.3d at 957, Pet. App. 73a), in view of its earlier ruling in *BellSouth Advertising & Publishing Corp. v. Donnelley Information Publishing, Inc.*, 933 F.2d 952 (11th Cir. 1991), *vacated and reh'g en banc granted*, 977 F.2d 1435 (11th Cir. 1992), *and on reh'g*, 999 F.2d 1436 (11th Cir. 1993) (*en banc*), *cert. denied*, 510 U.S. 1101, 114 S.Ct. 943, 127 L.Ed.2d 232 (1994).

Microdos' suggestion of rehearing *en banc* was granted. 67 F.3d 276, 277, Pet. App. 74a, 75a.

On June 10, 1997, the Eleventh Circuit vacated the preliminary injunction entered by the district court and remanded for further proceedings. In its opinion, the Eleventh Circuit noted "the district court, in ruling on the summary judgment motions, did not have the benefit of our *en banc* opinion in *BellSouth*". 115 F.3d at 1511, Pet. App. 3a. The Eleventh Circuit held that the district court erred in finding that Warren's "principal community system" of selection of material was sufficiently creative and original to be entitled to copyright protection. The court also found that Warren could not show a "likelihood of success on the merits" because it was merely the industrious gatherer and discoverer of facts, rather than an author of an original work. 115 F.3d at 1520, Pet. App. 26a.

2. Statement Of Facts

A. Warren's "Selection" Of Material For Its "Factbook" Was Mere Discovery Of Community Names From Cable System Operators

Warren publishes annually a bound-book compilation of facts about television cable systems across the United States known as the *Television and Cable Factbook* ("*Factbook*"). The directory is arranged state-by-state in alphabetical order from Alabama to Wisconsin. Within each state section is listed, in alphabetical order, communities receiving cable television service. 115 F.3d at 1511, Pet. App. 4a. Factual data about the cable system is printed with a lead or "principal" community. For cable

systems serving more than one community, the data is not reprinted; rather, the smaller communities are cross-referenced to the larger community served by that cable system. 115 F.3d at 1512, Pet. App. 5a. In many cases, a cable system is a single-community system, and thus there is only one possible principal community. 115 F.3d at 112, Pet. App. 5a. For 360 of 406 cable systems in Illinois (over 88 percent), the principal community is the single community or the community with the largest number of subscribers. 115 F.3d at 1519, n. 30, Pet. App. 23a. Pages A.1 attached to this brief illustrates the alphabetical listing and the cross-referencing of communities served by cable systems in the *Factbook*. See 9SR.

The record below establishes how Warren "selected" the "principal community" under which to list factual data with cross-references from the smaller communities (if any) served by a particular cable system. Lynn Levine, Director of Market Research and Data Sales for Appellant Warren, explained how Warren used a number of techniques to discover the principal community names. Warren calls cable companies across the United States and asks them which communities the cable system serves. 115 F.3d at 1517, 1520, Pet. App. 18a, 24a citing Levine depo. p. 53. In response, the cable companies identified the communities served. "The record indicates that it is the cable operators, not Warren, that determine, in the case of a multiple-community system, the community name under which to list the factual data." 115 F.3d at 1520, Pet. App. 26a. Levine also stated that Warren "looked at what was on record at the FCC" for facts about cable systems. Levine depo. pp. 61, 62, 63, 82. The record also shows Warren relied in great part on questionnaire

responses received from the cable operators for review and updating of facts. 115 F.3d at 1520, Pet. App. 24a. Levine depo. p. 35; P. Warren depo. p. 117; 10SR-3. Cable operators also sent copies of FCC reports to Warren to use in updating its cable system facts. Levine depo. pp. 42-44.

B. Microdos's Database Used Federal Communications Commission Reports Which Identify Cable Systems And Communities Served

Appellee Microdos markets a compilation of facts about cable systems in a computer software package titled "Cable Access". The Cable Access program provides detailed information about cable systems and is searchable by community name. 115 F.3d at 1512, Pet. App. 6a.

The names of the communities served by each cable system were obtained from Federal Communication Commission (FCC) public records (115 F.3d at 1519, n. 30, Pet. App. 23a, 24a) as well as other resources, including cable system operators and the Appellant's *Factbook*. The FCC requires operators of cable systems to report on FCC Form 325 the names of the community or communities served. Levine depo. p. 44; 47 CFR §§ 76.12, 76.400, and 76.403 (see 1SR-8 and 9), 1SR-10. The FCC assigns a unique code to each cable system and also to each community, and distributes Form 325 reports about cable systems and communities. P. Payne depo. pp. 37-38; 3SR; 4SR; 5SR; 6SR; 7SR; 8SR; 13SR. The community code and the system code are keys for indexing the FCC reports in order to research facts about each cable system. A cable system may serve one or more communities. Page A.2

attached to this brief was taken from SR13 and the page illustrates a single community cable system (Herscher, Illinois) and a multiple community cable system (Washington Park, Illinois) and some of the FCC public records for each.

The parties agreed to use Illinois as a test state for evaluating the issue of substantial similarity between the *Factbook* and the *Cable Access* database. In Illinois, 233 of 406 cable systems, or over 57 percent, are single community cable systems, according to FCC records. 10SR; R5-51-AFF of R. Payne, page 7. "The record shows that in the Illinois section of the *Factbook*, approximately fifty-five percent of the principal communities are single community systems." 115 F.3d at 1519, n. 30, Pet. App. 23a. A copy of an FCC report in the record at 16SR bears two sequential numberings. On the left is marked potential cable systems in Illinois; on the right is actual cable systems after eliminating duplicates and errors. The report shows 401 actual cable systems in Illinois (as of the date of the report). Of these, 233 are single community cable systems. A simple count of the Illinois cable systems in the *Factbook* shows that 231 out of 405 (or 57 percent) are single community cable systems. 9SR-B259 to B320. The remaining 174 cable systems in the *Cable Access* database serve more than one community, and for most, the lead community has the highest number of subscribers as listed in the FCC records. For over 360 of 406 cable systems in Illinois (over 88 percent) the lead community is either the single community or the community with the largest number of subscribers. 115 F.3d at 119, n. 30, Pet. App. 23a.

REASONS FOR DENYING THE PETITION FOR WRIT OF CERTIORARI

1. Certiorari Is Not Warranted Because The Eleventh Circuit Decision Is Merely An Application Of *Feist* and *BellSouth* To The Facts Shown In The Record: Appellant Disagrees With The Factual Findings And The Application Of An Established Rule Of Law.

The Appellant claims a compilation copyright in a comprehensive directory of cable systems indexed by geographical community names. Appellant's petition for writ of certiorari arises from its dissatisfaction with the application of the law in *Feist* and *BellSouth* to the factual findings of the district court and the *en banc* court below. Such disagreement regarding factual determinations are generally insufficient to obtain grant of the writ of certiorari for appeal to the Supreme Court. *Rules of the Supreme Court of the United States* (May 1, 1997). Further, even a misapplication of a properly stated rule of law is not grounds for granting certiorari. *Id.*

Certiorari is not appropriate in this case because the Eleventh Circuit applied the proper and consistent legal standard to the facts surrounding appellant's selection of material for inclusion in its compilation. The court below determined that the selection of community names in the comprehensive list of communities served by cable systems lacks subjective originality and the Appellant's *Factbook* is therefore not protectable by compilation copyright.

This Court has established the legal principles of compilation copyright law which the court below and the

other circuit courts have consistently followed. Where the compilation results from the originality of the author making the selection through subjective exercise of thought or judgment, the resulting compilation is copyrightable. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991); *see, also, Key Publications v. China Town Today Publishing Enterprises, Inc.*, 945 F.2d 509, 513 (2nd Cir. 1991) (applying *Feist* to hold that selection copyrightable because it "implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation"); *CCC Information Services v. MacLean Hunter Market Reports, Inc.*, 44 F.3d 61 (2nd Cir. 1994) (applying *Feist* to hold that predictions of future expected values for average vehicles was copyrightable compilation); *Lipton v. Nature Co.*, 71 F.3d 464, 470 (2nd Cir. 1995) (applying *Feist* to hold that "subjective creative judgment" was exercised in selecting 77 terms of venery from hundreds gathered from fifteenth century manuscripts); *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 140 (5th Cir. 1992) (citing *Feist* and holding that author required to make independent choices to select information from numerous sources).

Originality by a copyright author accordingly requires subjective judgment, thought, or constructive imagination, and in the absence of subjective selection, the work is not protected by compilation copyright. *Feist*, 499 U.S. 340, 111 S.Ct. 1282 (selection of listings which is obvious, mechanical or routine so as to require no creativity whatsoever lacks originality); *BellSouth*, 999 F.2d 1436 (11th Cir. 1993) (*en banc*) (applying *Feist* to hold that idea of dividing churches by denomination or attorneys by area of specialty is not copyrightable); *Mid America*

Title Co. v. Kirk, 59 F.3d 719 (7th Cir. 1995) (applying *Feist* and holding no creativity in selecting facts which effect marketable title from the domain of facts that could be included); *National Rifle Assn. v. Handgun Control Federation*, 844 F. Supp. 1178 (D.C. Ohio 1992) (applying *Feist* to hold that selection of factual information about state legislators was mechanical and routine). Indeed, *techniques* used in systems for the discovery of facts are not rewarded with compilation copyright for the gathered facts. *BellSouth*, 999 F.2d at 1441.

The *en banc* court below followed this Court's guidelines on the level of originality required for compilation copyright. The Eleventh Circuit properly applied the principles of compilation copyright under the Copyright Statute, the Constitution, and this Court's case law to the facts in the record (115 F.3d at 1511, Pet. App. 3a) and found that the *selection* by Warren in its system lacked originality (115 F.3d at 1517-1519, Pet. App. 19a, 21a, 22a), that Warren did not apply sufficient subjective judgment and thought to the collected facts (115 F.3d at 1518, Pet. App. 21a) and that the resulting comprehensive list of geographic names for areas served by cable systems was not an expression protectable by compilation copyright. 115 F.3d at 1520, Pet. App. 26a. Such an application of the Supreme Court law in *Feist* to the record does not warrant grant of certiorari.

Consistent with the rulings of other courts of appeals, the court below properly excluded copyrightability in a factual compilation in which there was no selection or original authorship exercised in applying the "organizing principle" by the author. The court below properly vacated the decision of the district court after

finding that Warren had failed to establish facts showing that the selection at issue was protectable expression under copyright law.

Introduction To Sections 2, 3, and 4

Following *de novo* review, the Eleventh Circuit held that Appellant's *Factbook* was not copyrightable on two primary grounds: (1) Appellant Warren's actions were not acts of authorship because Warren made no selection, but included in its *Factbook* compilation the entire universe of cable systems known to Warren (115 F.3d at 1517, 1518, Pet. App. 19a, 21a), and because the selection of the community name under which to list the factual data about the cable system was made by the cable systems, not Warren, which merely discovered those facts (115 F.3d at 1519-1520, Pet. App. 22a, 26a); and (2) the copyright statute excludes copyrights in "systems" under 17 U.S.C. § 102(b), and thus the district court's conclusion that Appellant's *system* of selection was protectable was not correct (115 F.3d at 1517-1519). The court offered a third alternative ground in footnote 27: that the expression of listing cable systems by the name of the communities served, with cross-referencing from smaller communities, does not survive the application of the copyright merger doctrine. 115 F.3d at 1531, n. 27. Each of these grounds, discussed below, is sufficient to uphold the *en banc* decision.

2. Certiorari Is Not Warranted Because The Eleventh Circuit Properly Applied The Compilation Copyright Law Of *Feist* and *BellSouth* To The Record And Held There Was Not Sufficient Creativity Or Originality In Warren's Actions To Entitle It To Compilation Copyright Protection

a. There Was No Originality In Warren's "Selection" Of All Known Cable Systems

The *en banc* court applied the legal guidelines of *Feist* and *BellSouth* to the facts in the record and held that Appellant Warren did not exercise original selection in its *Factbook*:

> [Warren] did not exercise any creativity or judgement in selecting cable systems to include in its Factbook, but rather included the entire relevant universe known to it. The only decision that it made was that it would not list separate information for each community that was part of a multiple community cable system. In other words, it decided to make the Factbook commercially useful.

115 F.3d at 1519, Pet. App. 21a. The court below found that Warren failed to show that it exercised any creativity or judgement in "selecting" cable systems to include in the *Factbook*. 115 F.3d at 1518, Pet. App. 21a.

Warren contends that this holding conflicts with the decision in *Eckes v. Card Prices Update*, 736 F.2d 859, 862-863 (2nd Cir. 1984). Pet. App. 18. In *Eckes*, the court found that the compiler exercised judgment in choosing whether a baseball card was "premium". The compiler thus independently selected certain baseball cards to

have a particular characteristic, i.e., the card was "premium." In contrast, Warren's selection of all cable systems does not provide the selected cable system with a distinguishing characteristic. The holding accordingly does not conflict with *Eckes*.

The *en banc* court below found as "plainly wrong" Warren's assertion that its system of listing communities does not include the entire universe of cable systems. 115 F.3d at 1518, Pet. App. 19a. The *en banc* court pointed out that the district court understood the requirement for subjective selection:

> In an unintentionally prescient footnote, however, the district court noted: This is not to say that the selection of cable systems would be copyrightable in all cases. Had Warren selected every cable system listed by the FCC then there would not be sufficient originality in the "selection" to warrant copyrightability.

115 F.3d at 1518, Pet. App. 19a.

Warren contends in its brief that "nothing in the record suggests the selection of cable systems in the *Factbook* was dictated by external forces or was a convention." Pet. App. 13. This is not correct. The FCC 325 report in 16SR identifies 405 discrete cable systems in the test state of Illinois. Warren's *Factbook* lists 406 Illinois cable systems. The *en banc* court noted that the district court erred in comparing the number of principal communities with the number of individual communities listed by the FCC; saying this was "comparing apples to oranges." 115 F.3d at 1518, Pet. App. 20a. Warren's brief in support of the petition, however, continues the mistake of comparing the number of *cable systems* in its *Factbook*

(406) with the number of *communities* (724 identified by the FCC) served by the cable systems. Pet. App. 13.

b. There Was No Originality In Warren's Organizing Principle Of Grouping Cable Systems By Communities Served

Appellant Warren argues that the Eleventh Circuit's *en banc* decision denied compilation copyright in the *Factbook* on the grounds that Warren used an "organizing principle of commercial usefulness" in its system of selection of cable systems with community names listed alphabetically. Pet. App. 11-14. However, the decision below was not based on a finding of "commercial usefulness." Indeed, Warren fails to recognize that the "organizing principle" must involve the exercise of subjective originality in selecting material for inclusion for the resulting work to be protectable by compilation copyright. As discussed above, commercially useful directories resulting from subjective original selection according to an organizing principle have been held to be copyrightable. *See, Key Publications, supra.*

Warren contends that it produced a unique grouping of communities and cable systems based on the way the cable systems actually developed, by grouping communities being offered the same services at the same prices by the cable systems. 115 F.3d at 1517, Pet. App. 18a. This is nothing more than a statement of how cable systems actually operate within a given geographical franchise. No franchise authority would permit a cable system to offer the same services at different prices within the

geographical area of the franchise. As the court below stated:

> Even if the industry was newly defined, as the dissent contends, when Warren organized cable systems under principal communities, however, the creative element is still lacking in Warren's compilation. The mere discovery of an organizing principle which is dictated by the market is not sufficient to establish creativity. "The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence." *Feist*, 499 U.S. at 347, 111 S.Ct. at 1288. The same can be said for an organizing principle like the "principal community." Thus, even if Warren discovered the existence of the principal community as an organizing concept, Warren did not create this organization.

115 F.3d at 1520, n. 31, Pet. App. 25a.

c. Warren's "Selection" Of Principal Community Is Merely The Discovery Of Facts And Is Original To The Cable Operators, Not To Warren

The court below found that Warren's "selection" of a principal community in its compilation was merely the discovery of facts. 115 F.3d at 1519, 1520, Pet. App. 23a, 24a. The principal community was selected by contacting the cable operator to determine which community it considered the lead community within the cable system. 115 F.3d at 1520, Pet. App. 24a. The court below applied *BellSouth* and observed that the acts in this case were

likewise not acts of authorship but techniques for the discovery of facts:

> Simply because Warren may have been the first to discover and report a fact on cable systems does not translate these acts of discovery into acts of creation entitled to copyright protection. *Feist*, 499 U.S. at 347, 111 S.Ct. at 1288, 113 L.Ed.2d 358 (distinguishing creation from discovery). Just as the Copyright Act does not protect industrious collection, it affords no shelter to the resourceful, efficient, or creative collector. *BellSouth*, 999 F.2d at 1441.

115 F.3d at 1520; Pet. App. 24a, 25a.

Even assuming selection of the principal community for the *Factbook* was creative and original, the court below found that the selection was not Warren's, but rather was that of the cable operators contacted by Warren:

> The record indicates that it is the cable operators, not Warren, that determine, in the case of a multiple-community system, the community name under which to list the factual data for the entire cable system. Therefore, Warren cannot prevail in its claim that it undertakes original selection in employing the principal community concept. Rather, it has created an effective system for determining where the cable operators prefer to have the data listed. While Warren may have found an efficient method of gathering this information, it lacks originality, which is the *sine qua non* of copyright. *See Feist*, 499 U.S. at 345, 111 S.Ct. at 1287. Thus, the district court erred in finding that Warren's principal community

> "system" was sufficiently creative and original to be entitled to copyright protection.

115 F.3d at 1520, Pet. App. 26a.

As the Supreme Court noted in *Feist*, originality of selection may also fail if a court concludes that the selection was dictated by another entity and not by the copyright claimant. *Feist*, 499 U.S. at 361, 362, 111 S.Ct. at 1296, 1297. Similarly, in the present case, the selection of community was dictated by an outside entity (i.e., the cable system operator) and not by the claimant Warren.

3. Certiorari Is Not Warranted Because "Systems" Under 17 U.S.C. § 102(b) Are Clearly Excluded From Copyright Protection

Warren practiced a system of discovering facts about cable systems to determine the names of the communities served by the cable systems. The system used various techniques, including FCC records, telephone calls, and questionnaires, to discover facts about the cable systems and the community name the cable system operator considered the principal community. Warren then listed the community names in its compilation as an index to the cable system facts.

The court below properly held that Appellant's system of learning community names is not protectable by copyright because the Copyright Statute bars copyright for "systems". 17 U.S.C. § 102(b).

Warren claims that the issue is the copyrightability of its *selection* of cable systems included in the directory. Pet. App. 8. Warren describes this selection process in detail

in support of its position. Pet. App. 4-6. Warren then claims that it is not seeking "copyright protection for the underlying idea of its 'system' or for any aspect of its data collection efforts." Pet. App. 9. Warren's reliance on a detailed system of selection of data as the basis for showing copyrightable subject matter on the one hand, and Warren's claim that it is seeking protection only for the resulting *expression* of its system of grouping cable systems by geographical area, is mere semantics.

If copyright of such selection were possible, as Appellant claims, then one could employ a complicated method of gathering names for a telephone book and a complicated computer program for sorting the names by area and alphabetically, and then claim copyright protection for the resulting expression of a list of names. *Feist* makes clear that this is not the law. *See, Feist*, 499 U.S. at 357-359, 111 S.Ct. at 1294, 1295.

Warren claims that the panel's holding conflicts with the ruling in *Toro Co. v. R&R Products Co.*, 787 F.2d 1208 (8th Cir. 1986). Appellant proffers *Toro* for the proposition that 17 U.S.C. § 102(b) does not *per se* prohibit a system from obtaining copyright protection. However, in that case, the Eighth Circuit affirmed the district court ruling, holding that the appellant's parts numbering system was *not* copyrightable. The court held that § 102(b) did not answer the question of whether the parts numbering system at issue in that case contained the requisite level of originality. The court relied not on § 102(b), but rather on the grounds that the parts numbering list lacked the requisite originality. *Toro*, 787 F.2d 1208. The discussion by the Eighth Circuit regarding § 102(b) was *dicta* and is not inconsistent with the Eleventh Circuit's holding.

The Eighth Circuit in *Toro* also stated that the Appellant could have no copyright protection for the *idea* of using numbers to designate replacement parts. *Toro*, 787 F.2d 1208. Likewise, in the present case, Appellant Warren cannot copyright the *idea* of grouping cable systems by the name of the geographical area served by that cable system. There can be no "monopoly on a system or method for performing commercial functions." R. Nimmer, *Nimmer On Copyright* (1997) § 2.18[C].

4. Certiorari Is Not Warranted Because The Eleventh Circuit Applied The Copyright Merger Doctrine To The Record And Held That The Expression In Warren's Work Merged With Its Idea

The petition for writ of certiorari should be denied because Warren's *Factbook* compilation listing facts about cable systems under the community name for the geographical area served by the cable systems merges with the idea behind such a geographically indexed directory. *BellSouth*, 999 F.2d at 1442 (expression not protected where there is only one or so few ways of expressing an idea that protection of the expression effectively accords protection to the idea); *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 154 U.S.P.Q. 193, 195 (1st Cir. 1967) (operation of the merger doctrine does not require the court to wait for an attempt to copyright all possible forms of expression nor does it condemn only the last form of expression); *Cooling Systems and Flexibles, Inc. v. Stewart Radiator, Inc.*, 777 F.2d 485, 492 (9th Cir. 1989) (protectable expression must be "something more than what must be unavoidably reproduced by anyone who wishes to use and restate facts."); *Matthew Bender Co. v. Kluwer Law Book*

Publishers, Inc., 672 F.Supp. 107, 111 (S.D.N.Y. 1987) (no copyright protection in headings used to display data regarding personal injury awards where the terms employed are the most logical and clear way of expressing the idea and "the only way of conveying the desired information").

In applying the merger doctrine, the court must first identify the idea that the work expresses, and then attempt to distinguish that idea from the author's expression. *Mason v. Montgomery Data, Inc.*, 967 F.2d 135, 138-139 (5th Cir. 1992). If the idea and its expression merges, then the doctrine applies and the expression is not protected. *Id.*

Warren contends that the idea behind the *Factbook* compilation should be expressed broadly as "a source of information about cable systems." Pet. App. 17. Warren implements that idea by listing facts about the cable system under the community name of the geographic area served by the cable system.

The expression of selecting community names to identify the geographic areas served by cable systems, with cross-indexing from smaller communities for multiple-community cable systems, merges with the idea. As the court below stated:

> Warren's claim of copyright in its selection of communities does not survive application of the merger doctrine. . . . If Warren were given protection in its principal community system, the concept of cross-referencing would be subsumed in its copyright. The idea of organizing by principal community yields very few ways, if not only one way, of expressing the data. Each

> SSO [single-community cable system] has only one principal community. Each MSO [multiple-community cable system] has one obvious principal community. For the compilation to be convenient and useful, not repetitive and onerous, however, the non-principal communities in each MSO must be cross-referenced to the principal community with the data listed only under the principal community. The customers for whom the Factbook and similar products are produced are not interested in having information repeated under every community served by a multiple-community system. Consequently, expression of the principal community selection has merged with the idea, and thus the selection of principal communities is uncopyrightable.

115 F.3d at 1518, n. 27, Pet. App. 21a, 22a.

The court below again described the "selection" of principal community:

> . . . in the case of a single-community system, there is only one community served and therefore only one possible principal community. Thus, no argument can be made regarding the selection of the principal community in the case of a single-community system.

115 F.3d at 1519, n. 30, Pet. App. 23a.

For example, there is but one way to express the community name for the geographical area around Chester, Illinois served by the cable system – that is "Chester." Now, if Warren instead had identified the geographical area as "a quaint town on a bluff overlooking the Mississippi River" – that might be original.

The court below continued:

> The record shows that in the Illinois section of the Factbook, approximately fifty-five percent of the principal communities are single-community systems. For the remaining principal communities, which are all part of multiple-community systems, Appellee Microdos contends that over two-thirds of them are simply the community in the multiple-community system that, according to FCC records, has the highest number of subscribers.

115 F.3d at 1519, n. 30, Pet. App. 23a.

The *en banc* decision also found that the community names were contained in FCC records:

> Warren cannot make any tenable argument regarding selection in these instances either, given that their "selection" is nothing more than discovery of facts that are contained in the publicly-available FCC records.

115 F.3d at 1519, n. 30, Pet. App. 23a.

The expression of a geographical index (i.e., community names) to identify cable systems merges with its idea, and the work is therefore not protectable expression, as the court below properly held, and certiorari is therefore not appropriate.

CONCLUSION

In accordance with the foregoing reasoning and authority, Appellee requests that the petition for certiorari be DENIED.

Respectfully submitted,

ROBERT B. KENNEDY
CARL M. DAVIS II
LESLIE C. RUITER

KENNEDY, DAVIS & KENNEDY
Suite 1250
400 Northpark Town Center
1000 Abernathy Road
Atlanta, Georgia 30328

Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago.
Current originations: Time-weather.
Fee: $18.00-$25.00 installation; $9.95 monthly.
Tier 1
Subscribers: 38 (01/01/85). Began: October 1, 1984.
Programming (via satellite): Cinemax.
Fee: $18.00 installation; $10.00 monthly.
Tier 2
Subscribers: 214 (01/01/85). Began: January 1, 1980.
Programming (via satellite): HBO.
Fee: $18.00 installation; $10.00 monthly.
Equipment: GTE Sylvania headend; GTE Sylvania amplifiers; Times cable.
Miles of plant: 6.0 (coaxial). Homes passed: 757.
Manager: John Beck. Chief technician: Dan Lowing.
City fee: None.
Ownership: Cass Cable TV Inc. (see Cable Group Ownership), 100%.
Note: Current information not available.

Wabash County—See MOUNT CARMEL, IL.

WADSWORTH—See WAUKEGAN, IL.

WALNUT—Walnut Cable, Box K, 1416 State St., Bettendorf, IA 52722. Phone: 319-359-0358. County: Bureau. Population: 1,513.
TV Market Ranking: Below 100. Original franchise award date: December 1, 1982. Franchise expiration date: December 1, 1997. Began: July 1, 1983.
Channel capacity: N.A. Channels available but not in use: N.A.
Basic Service
Subscribers: 407 (05/15/87).
Programming (received off air): WIFR-TV (C), Freeport-Rockford; WORF-TV (I), WREX-TV (A), WTVO (N) Rockford.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; USA Network.
Fee: $25.00 installation; $10.45 monthly.
Expanded Basic 1
Subscribers: N.A. Began: N.A.
Programming (via satellite): Discovery Channel; Lifetime; MTV; Nashville Network; Nickelodeon.
Fee: $3.95 monthly.
Tier 1
Subscribers: N.A. Began: N.A.
Programming (via satellite): HBO; Showtime.
Fee: $15.00 installation; $9.00 monthly (each).
Miles of plant: 7.0 (coaxial). Homes passed: 600.
Ownership: Triax Communications Corp. (see Cable Group Ownership), 100%. Purchased from Midland Cablevision Systems Inc., June 1987.

WAMAC—See CENTRALIA, IL.

WAPELLA—See HEYWORTH, IL.

WARREN—Dowden Communications of Illinois, Box 615, 216 W. Main St., Lena, IL 61048. Phone: 815-369-5261. County: Jo Daviess. Also serves Apple River. Population: 2,249.
TV Market Ranking: 97. Original franchise award date: N.A. Franchise expiration date: March 1, 1997. Began: March 31, 1983.
Channel capacity: 36. Channels available but not in use: 16.
Basic Service
Subscribers: 455 (11/30/86).
Programming (received off air): KDUB-TV (A), Dubuque; WIFR-TV (C), Freeport-Rockford; WHA-TV (P), WISC-TV (C), Madison; WQRF-TV (I), WREX-TV (A), WTVO (N) Rockford.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; ESPN; Lifetime; MTV; Nashville Network; Nickelodeon; USA Network.
Current originations: Time-weather; news ticker; stock ticker.
Fee: $25.00 installation; $11.95 monthly.
Tier 1
Subscribers: 72 (11/30/86). Began: March 31, 1983.
Programming (via satellite): Cinemax.
Fee: $25.00 installation; $9.95 monthly.
Tier 2
Subscribers: 188 (11/30/86). Began: March 31, 1983.
Programming (via satellite): HBO.
Fee: $25.00 installation; $9.95 monthly.
Tier 3
Subscribers: 40 (11/30/86). Began: March 31, 1983.
Programming (via satellite): Showtime.
Fee: $25.00 installation; $9.95 monthly.
Equipment: Scientific-Atlanta headend; Scientific-Atlanta amplifiers; Scientific-Atlanta cable; Scientific-Atlanta set top converters; Vitek traps; Scientific-Atlanta satellite antenna; Scientific-Atlanta satellite receivers.
Miles of plant: 18.8 (coaxial). Homes passed: 852. Total homes in franchised area: 852.
Manager: Gary Crosby. Chief technician: Larry Kuepker.
City fee: 5% of gross.
Ownership: Dowden Cable Partners L.P. (see Cable Group Ownership), 100%.

WARREN TWP.—See WAUKEGAN, IL.

WARRENSBURG—Cable Systems USA, Box 600, RD 1, Tionesta, PA 16353. Phone: 814-755-3618. County: Macon. Also serves Latham. Population: 1,936.
TV Market Ranking: 64. Original franchise award date: N.A. Franchise expiration date: January 21, 1995. Began: N.A.
Channel capacity: 36. Channels available but not in use: 19.
Basic Service
Subscribers: 425 (12/31/87).
Programming (received off air): WCIA (C), Champaign; WAND (A), WFHL (I), Decatur; WICS (N), WRSP-TV (I), Springfield; WILL-TV (P) Urbana-Champaign.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; ESPN; Nashville Network; USA Network.
Fee: $35.00 installation; $13.40 monthly; $2.00 monthly (each additional set).
Tier 1
Subscribers: 86 (12/31/87). Began: N.A.
Programming (via satellite): Cinemax.
Fee: $10.00 installation; $8.00 monthly.
Tier 2
Subscribers: 36 (12/31/87). Began: N.A.
Programming (via satellite): Disney Channel.
Fee: $10.00 installation; $6.00 monthly.
Tier 3
Subscribers: 126 (12/31/87). Began: N.A.
Programming (via satellite): HBO.
Fee: $10.00 installation; $10.00 monthly.
Tier 4
Subscribers: 12 (12/31/87). Began: N.A.
Programming (via satellite): Showtime.
Fee: $10.00 installation; $10.00 monthly.
Miles of plant: 15.1 (coaxial). Homes passed: 690.
Manager: Melanie Ward. Chief technician: Walt Ziemba.
City fee: 3% of gross.
Ownership: Cable Systems USA Assoc. (see Cable Group Ownership), 100%. Purchased from First Rural Cable Inc.

WARRENVILLE—See WEST CHICAGO, IL.

WARSAW—See KEOKUK, IA.

WASHBURN—See ROANOKE, IL.

WASHINGTON—See PEORIA, IL.

WASHINGTON PARK—Dowden Communications of Illinois Inc., Box 615, 216 W. Main St., Lena, IL 61048. Phone: 815-369-5161. Counties: Madison & St. Clair. Also serves Fairmont City, Madison County, St. Clair County (unincorporated portions). Population: 10,634.
TV Market Ranking: 11. Original franchise award date: N.A. Franchise expiration date: June 1, 1997. Began: June 23, 1983.
Channel capacity: 36. Channels available but not in use: 12.
Basic Service
Subscribers: 1,679 (11/30/86).
Programming (received off air): KDNL-TV (I), KETC (P), KMOV (C), KNLC (I), KSDK (N), KTVI (A) St. Louis.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; WWOR-TV (I) New York; Black Entertainment TV; CBN Cable Network; CNN Headline News; ESPN; MTV; Nashville Network; Nickelodeon; The Weather Channel; USA Network.
Current originations: Time-weather; news ticker; stock ticker.
Fee: $25.00 installation; $11.95 monthly.
Tier 1
Subscribers: 856 (11/30/86). Began: June 23, 1983.
Programming (via satellite): Cinemax.
Fee: $25.00 installation; $9.45 monthly.
Tier 2
Subscribers: 1,086 (11/30/86). Began: June 23, 1983.
Programming (via satellite): HBO.
Fee: $25.00 installation; $9.45 monthly.
Tier 3
Subscribers: N.A. Began: N.A.
Programming (via satellite): Playboy Channel.
Fee: $25.00 installation; $7.90 monthly.
Equipment: Scientific-Atlanta headend; Scientific-Atlanta amplifiers; Scientific-Atlanta cable; Compuvid character generator; Scientific-Atlanta & Hamlin set top converters; Vitek traps; Scientific-Atlanta satellite antenna; Scientific-Atlanta satellite receivers.
Miles of plant: 74.8 (coaxial). Homes passed: 5,092. Total homes in franchised area: 5,092.
Manager: Gary Crosby. Chief technician: Larry Kuepker.
City fee: 5% of gross.
Ownership: Dowden Cable Partners L.P. (see Cable Group Ownership), 100%.

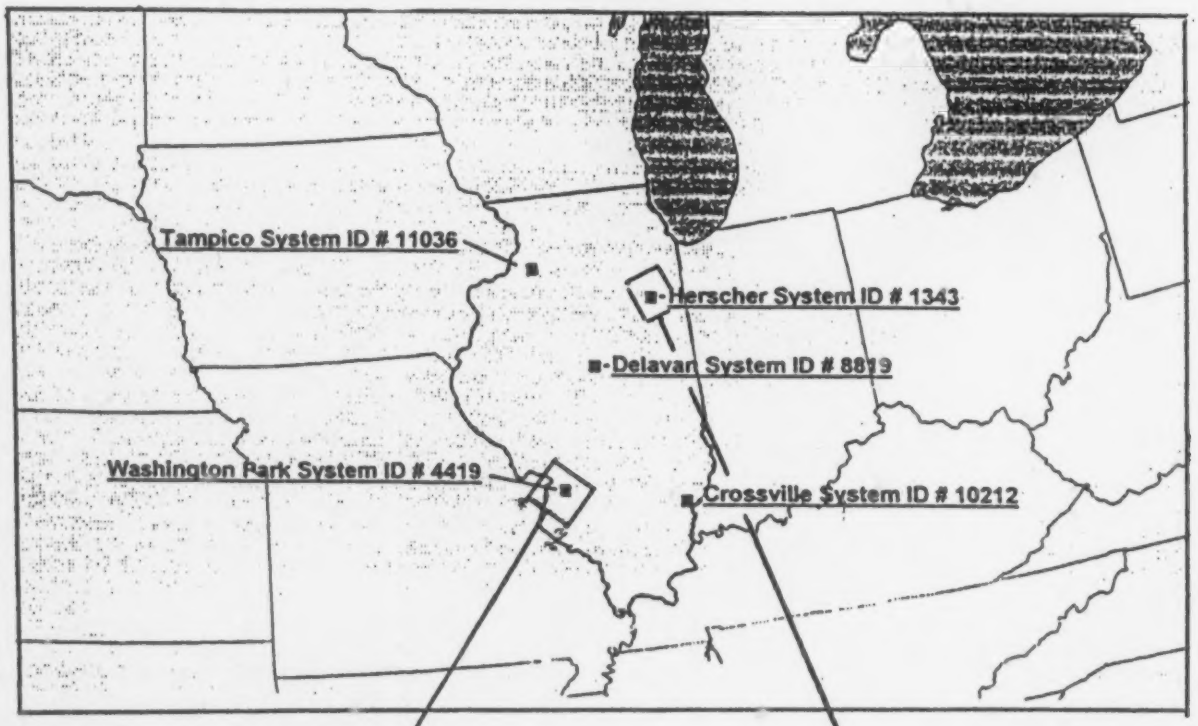
WATAGA—Nova Communications Inc., 562 N. Henderson Rd., Galesburg, IL 61401. Phone: 309-342-8384. County: Knox. Also serves Henderson. Population: 1,365.
TV Market Ranking: 60. Original franchise award date: N.A. Franchise expiration date: N.A. Began: September 1, 1986.
Channel capacity: 35. Channels available but not in use: 23.
Basic Service
Subscribers: 322 (07/01/85).
Programming (received off air): KWQC-TV (N), Davenport; KIIN-TV (P), Iowa City; WQAD-TV (A), Moline; WHBF-TV (C) Rock Island.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; ESPN; Nashville Network.
Fee: $30.00 installation; $8.75 monthly.
Tier 1
Subscribers: N.A. Began: September 1, 1984.
Programming (via satellite): Cinemax; HBO.
Fee: $10.00 monthly (each), $18.50 (both).
Homes passed: 560.
Manager: Robert G. Fischer Jr.
Ownership: Triax Communications Corp. (see Cable Group Ownership), 100%. Purchased from Nova Communications Inc., Sept. 1987.
Note: Current information not available.

WATERLOO—Cencom Cable Assoc. Inc., 200 W. Division St., Maryville, IL 62062. Phone: 618-345-8121. County: Monroe. Population: 4,646.
TV Market Ranking: 11. Original franchise award date: N.A. Franchise expiration date: January 1, 1996. Began: January 1, 1981.
Channel capacity: 36 (2-way capable). Channels available but not in use: 3.
Basic Service
Subscribers: 720 (01/31/85).
Programming (received off air): KDNL-TV (I), KETC (P), KMOV (C), KNLC (I), KPLR-TV (I), KSDK (N), KTVI (A) St. Louis.
Programming (via satellite): WTBS (I) Atlanta; WGN-TV (I) Chicago; CBN Cable Network; CNN; CNN Headline News; ESPN; Lifetime; MTV; Nashville Network; Nickelodeon; The Weather Channel; USA Network.
Fee: $25.00 installation; $9.00 monthly.
Tier 1
Subscribers: 925 (01/31/85). Began: N.A.
Programming (via satellite): HBO; Showtime; The Movie Channel.
Fee: $10.00 installation; $10.00-$10.75 monthly (each).
Equipment: Scientific-Atlanta headend; Theta-Com amplifiers; Scientific-Atlanta cable; Pioneer set top converters; Scientific-Atlanta satellite antenna; Scientific-Atlanta satellite receivers.
Miles of plant: 27.0 (coaxial). Homes passed: 1,538. Total homes in franchised area: 1,538.
Manager: Dave Trotell. Chief technician: Mathew Aldridge.
City fee: 3% of gross.
Ownership: Cencom Cable Assoc. Inc. (see Cable Group Ownership), 100%.
Note: Current information not available.

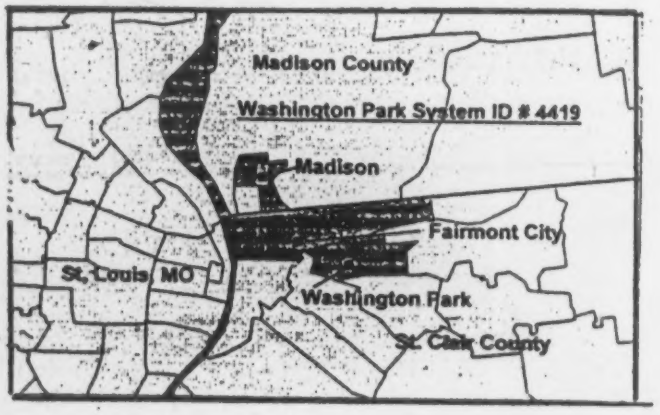
WATERMAN—Dowden Communications of Illinois, Box 615, 216 W. Main St., Lena, IL 61048. Phone: 815-369-5261. County: De Kalb. Also serves Hinckley, Shabbona. Population: 3,241.
TV Market Ranking: Below 100. Original franchise award date: N.A. Franchise expiration date: N.A. Began: December 17, 1984.
Channel capacity: 42. Channels available but not in use: 17.
Basic Service
Subscribers: 670 (11/30/86).
Programming (received off air): WEHS (I), Aurora; WBBM-TV (C), WCFC-TV (I), WCIU-TV (I), WFLD (I), WGN-TV (I), WLS-TV (A), WMAQ-TV (N), WTTW (P), WYCC (P), Chicago; WIFR-TV (C), Free-

BEST AVAILABLE COPY

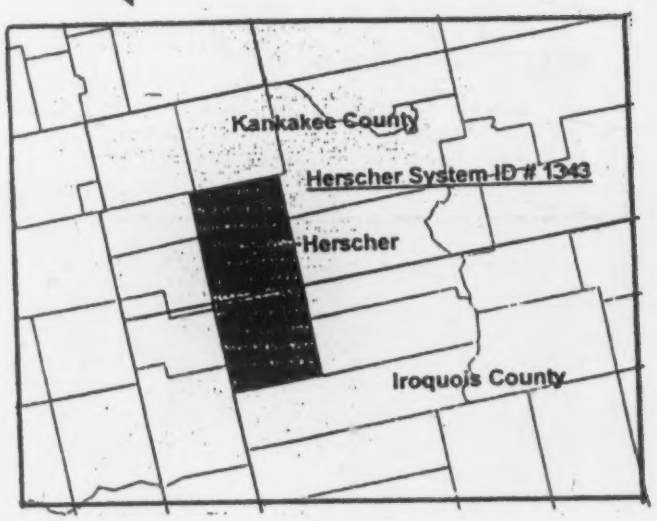
Several of the geographic areas in Illinois served by cable systems



Detail of Washington Park



Detail of Herscher



DATE: 08/04/88 FORM 325-SCHEDULE 2 - PHYSICAL SYSTEM STATISTICS-REPORT #1 - PAGE: 301

SYSTEM-ID	OPERATOR	CHANNEL CAP	CHANNEL USE	PAY TV	LOCAL PROGR	AERO FREQ	MARKET	HOMES-PASSED	SUBSCRIBERS	STRAND MILES	PERC	CODE	COMMUNITY		BEGAN	FILE
004419-01	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		2,927	787	26		IL0694	WASHINGTON PARK	X	8307	8706
	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		938	374	13		IL0695	FAIRMONT CITY		8311	8706
	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		344	139	6		IL1042	MADISON		8409	8706
	TRIAX MIDWEST ASSOCIATES	L	P			TOP 50 MKTS		900	397	19		IL0746	ST CLAIR		8304	8710
		35	26	Y	Y	Y		5,109	1,897	64	37.1	4				
001343-01	TCI OF ILLINOIS INC					OUTSIDE ALL		405	228	11		IL0291	HERSCHER	X	7812	8707
		22	15	Y	Y	N		405	228	11	56.3	1				